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By: Hanna Hacham 3-24-00
Hanna Hacham

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of John D. Baxter, et al.

Serial No.: 09/281,717

Examiner: Ogihara, N.

Filed: March 30, 1999

Art Unit: 1631

For: METHODS AND COMPOUNDS FOR MODULATING NUCLEAR RECEPTOR COACTIVATOR BINDING

Assistant Commissioner for Patents
Washington, D.C. 20231

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RESPONSE TO RESTRICTION REQUIREMENT

Responsive to the Restriction Requirement of February 24, 2000, Applicant respectfully elects Group I, Claims 1-16 and 30, drawn to a method of identifying a compound that modulates coactivator binding to a nuclear receptor, classified in class 514, subclass 1, with traverse.

The invention of claims of Group I and II should be examined concurrently.

Claims of Group I (claims 1-16 and 30) are characterized as a method for identifying a compound that modulates co-activator binding to a nuclear receptor. The sole claim of Group II (claim 17) is characterized as a method of identifying an agonist or antagonist of co-activator binding.

The Examiner required restriction of the inventions of claims of Groups I and II because they are "each drawn to different methods." The Examiner stated that "the inventions can be

shown to be distinct because each method has different goals, with different method steps, and because the criteria for evaluating modulators are different from those for identifying agonists and antagonists.”

The restriction requirement is respectfully traversed on the grounds that the concurrent examination on the merits of the invention of claims of elected Group I with the invention of the sole claim of Group II would not place a serious burden on the Examiner.

According to MPEP § 803, two criteria are necessary to justify a requirement for restriction between patentably distinct inventions:

- (a) The inventions must be independent or distinct as claimed; and
- (b) There must be a serious burden on the Examiner if restriction is not required.

“[A] serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in MPEP § 808.02.”

Applicants submit that it would not be unduly burdensome for the Examiner to prosecute the inventions of claims of Groups I and II in a single application. Both restriction Groups are classified by the Examiner in class 516, subclass 1. Contrary to the Examiner’s statement, the goals of the methods claimed in Group I and Group II are the same: to identify compounds that modulate co-activator binding of a nuclear receptor. The agonists and antagonists of co-activator binding claimed in Group II are included in the compounds that modulate co-activator binding to a nuclear receptor claimed in Group I. See specification at page 3, lines 18-22. Furthermore, the method steps, although not identical, are very similar. As explained in MPEP § 803, “If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.”

Accordingly, Applicants request that the restriction of the invention corresponding to claims of Groups I and II be withdrawn, and that they be examined concurrently on the merits.

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Conclusion

If in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned at (650) 843-5084.

Cooley Godward LLP
Attn: Patent Group
Five Palo Alto Square
3000 El Camino Real
Palo Alto, CA 94306-2155
Tel: (650) 843-5000
Fax: (650) 857-0663
MCJ:hh

By:

Respectfully submitted,
COOLEY GODWARD LLP



Madison C. Jellins
Reg. No. 35,555